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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/827,515	04/19/2004	Hiroshi Ohishi	52433/754	3475
7590 KENYON & KENYON One Broadway New York, NY 10004	04/18/2007		EXAMINER FIGUEROA, JOHN J	
			ART UNIT 1712	PAPER NUMBER
SHORTENED STATUTORY PERIOD OF RESPONSE 3 MONTHS	MAIL DATE 04/18/2007		DELIVERY MODE PAPER	

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/827,515	OHISHI ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	John J. Figueira	1712	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 22 January 2007.
- 2a) This action is FINAL.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-17 and 19-28 is/are pending in the application.
  - 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 14-17 and 19-28 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) All    b) Some \* c) None of:
    1. Certified copies of the priority documents have been received.
    2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413)
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	Paper No(s)/Mail Date: _____
3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date <u>11/13/2006</u>	5) <input type="checkbox"/> Notice of Informal Patent Application
	6) <input type="checkbox"/> Other: _____

## **DETAILED ACTION**

### ***Response to Amendment***

1. The 35 U.S.C. 112, second, paragraph rejection of claim 18 of record in item 4 on page 2 of the Office Action of July 19, 2006, hereinafter 'OA', has been withdrawn in view of the cancellation of the claim in the amendment in Applicant's response to OA filed January 22, 2007, hereinafter 'Response'.
2. The 35 U.S.C. 102 rejection of claims 14-17, 19-21 and 24-28 as anticipated by United States Patent Number (USPN) 5,237,004 to Wu et al., hereinafter 'Wu', previously made of record in item 6 on page 3 of OA, has been withdrawn in view of Applicant's amendment to the claims in Response.
3. The 35 U.S.C. 103 rejection of claims 14-17 and 19-28 as unpatentable over Wu in view of USPN 4,219,628 to Weemes, hereinafter 'Weemes', previously made of record in item 8 on page 5 of OA, has been withdrawn in view of Applicant's amendment to the claims in Response.

### ***Double Patenting***

4. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct

Art Unit: 1712

from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

5. Claims 14-17 and 19-28, as currently amended, are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-14 and 30 of U.S. Patent No. 6,783,825 B1 to Ohishi et al., hereinafter ‘Ohishi’.

Although the conflicting claims are not identical, they are not patentably distinct from each other because both sets of claims are drawn to a resin film that is laminated onto a metal sheet, said resin film comprising a polyester resin having an intrinsic viscosity of 0.5-2.0 dl/g (that can be crystalline in instant independent claim 16 and claim 4 in Ohishi); an elastomer resin (that can be core shell in instant independent claim 15 and claim 3 in Ohishi); and a vinyl polymer containing, either at least 1 wt% of a unit with an ethylene and/or a polar group (instant independent claim 14 and claims 1 and 2 in Ohishi), or an acrylate based polymer (instant independent claim 15 and claim

3 in Ohishi), wherein said resin film has a structure wherein the elastomer resin is finely dispersed in the polyester resin; at least a portion of the elastomer resin is capsulated by the vinyl polymer; and wherein each particle of the elastomer resin has a volume no greater than a sphere having a diameter of 1  $\mu\text{m}$  (Claim 5 in Ohishi).

### ***Response to Arguments***

#### **The 35 U.S.C. 112, second paragraph rejection (item 4 of OA)**

6. Applicant's arguments with respect to the captioned rejection of claim 18 have been considered but have become moot due to the withdrawal of the rejection in view of the cancellation of the rejected claim in Response.

#### **The 35 U.S.C. 102 Rejection over Wu (item 6 of OA)**

7. Applicant's arguments with respect to the 35 U.S.C. 102(b) rejection of claims 14-17, 19-21 and 24-28 as anticipated by Wu have been fully considered and deemed persuasive in view of the amendment to the independent claims in Response overcoming Wu because independent claims 14-16 now recite the resin film laminated on a metal sheet, and limits the volume of the elastomer resin particles to be no greater than 1 $\mu\text{m}$ , which are not taught or suggested in Wu. Thus, this rejection has been withdrawn.

#### **The 35 U.S.C. 103 rejection over Wu and Weemes (item 8 of OA)**

8. Applicant's arguments with respect to the 35 U.S.C. 103 rejection of claims 14-17 and 19-28 as unpatentable over Wu in view Weemes have been fully considered and

Art Unit: 1712

deemed persuasive in view of the amendment to the independent claims in Response for the same reasons discussed above regarding the 102 rejection over Wu. Thus, this rejection has been withdrawn.

***Conclusion***

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John J. Figueroa whose telephone number is (571) 272-8916. The examiner can normally be reached on Mon-Thurs & alt. Fri 8:00-5:30pm.

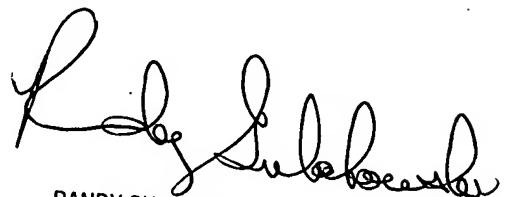
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Randy Gulakowski can be reached on (571) 272-1302. The fax phone

Art Unit: 1712

number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

JJF/RAG



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